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**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF UTAH, CENTRAL DIVISION**

COREL SOFTWARE, LLC,

Plaintiff,

v.

MICROSOFT CORPORATION,

Defendant.

Case No. 2:15-cv-00528-JNP

**DEFENDANT MICROSOFT
CORPORATION'S MOTION FOR
ISSUANCE OF LETTER ROGATORY**

JURY DEMANDED

Judge Jill N. Parrish

Pursuant to this Court's inherent authority to issue letters rogatory and 28 U.S.C. § 1781, Defendant Microsoft Corporation ("Microsoft"), by and through its undersigned attorneys, hereby requests this Court issue the attached letter rogatory to the Ontario Superior Court of

Justice of Canada to obtain documents and depositions from M. Kent Ledwell, of Gowling Lafleur Henderson LLP, and Adrian C. O'Donnell, of Perley-Robertson, Hill & McDougall LLP/s.r.l. Along with this Motion, Microsoft submits a supporting declaration with supporting attachments (Exhibit A), pursuant to local rule DUCivR 7-1(c), and the proposed letter rogatory for the Court's approval (Exhibit B).

BACKGROUND

Microsoft is a world leader in developing, licensing, and supporting a wide range of software products, services, and devices that deliver new opportunities, greater convenience, and enhanced value to people's lives. Corel alleges that certain Microsoft products infringe U.S. Patent Nos. 6,731,309 ("the '309 Patent"), 7,827,483 ("the '483 Patent"), and 8,700,966 ("the '966 Patent") (collectively, "the asserted patents"). M. Kent Ledwell is a Partner and Patent Agent at Gowling Lafleur Henderson LLP in Ottawa, Canada. Adrian C. O'Donnell is a Patent Specialist at Perley-Robertson, Hill & McDougall LLP/s.r.l. in Ottawa, Canada. Corel identified both Mr. Ledwell and Mr. O'Donnell in its initial disclosures as individuals who have represented Corel Corporation for patent prosecution matters, including matters involving the asserted patents and/or related patents. [See Attach. 1 to Ex. A at 4.] Both Mr. Ledwell and Mr. O'Donnell are likely to have material information regarding the prosecution of the asserted patents, validity or invalidity of the asserted patents, inventorship of the asserted patents, and prior art to the asserted patents.

On November 12, 2015, Microsoft notified Corel that it intended to serve discovery requests on Mr. Ledwell and Mr. O'Donnell, attaching subpoenas for documents and deposition testimony. [Attach. 2-3 to Ex. A.] On November 20, 2015, counsel for Corel notified Microsoft

that they were unable to accept service for Mr. Ledwell and Mr. O'Donnell. [Attach. 4 to Ex. A at 2.] Moreover, on November 23, 2015, counsel for Corel indicated that they would not agree to refrain from calling Mr. Ledwell and Mr. O'Donnell at trial. [Attach. 4 to Ex. A at 1.] Therefore, Microsoft has no choice but to proceed with discovery through the issuance of a letter rogatory. Attorneys representing Microsoft independently tried to contact Mr. Ledwell and Mr. O'Donnell on each day of January 25 and 26, 2016 in an attempt to reach an agreement with them to voluntarily provide the discovery sought. However, both Mr. Ledwell and Mr. O'Donnell failed to respond, which indicates that they will not provide any discovery unless compelled by a court with jurisdiction in Ontario. The deadline to serve written discovery before claim construction is currently set for May 24, 2016. [Dkt. No. 38 at 4.] Microsoft can no longer tolerate delay in obtaining discovery concerning the basic circumstances surrounding the prosecution of the asserted patents and related patents, and therefore must bring this motion in order to preserve its rights to obtain this discovery.

ARGUMENT

Microsoft requests that this Court issue a letter rogatory to the Ontario Superior Court of Justice to obtain documents and testimony from Mr. Ledwell and Mr. O'Donnell. Canada is not a signatory to the Hague Convention of 18 March 1970 on Taking Evidence Abroad in Civil or Commercial Matters. *See* U.S. Department of State, *Legal Considerations: Canada*, <http://travel.state.gov/content/travel/en/legal-considerations/judicial/country/canada.html> (last visited Feb. 19, 2016) (noting that Canada is not a party to the Hague Evidence Convention). Thus, discovery must be obtained through a letter rogatory issued by this Court to the appropriate Canadian court.

A letter rogatory is a formal written request sent by a U.S. court to a foreign court asking that a witness residing within that foreign court's jurisdiction provide documents, a deposition, or both for use in a pending action before the requesting court. *Intel Corp. v. Advanced Micro Devices, Inc.*, 542 U.S. 241, 247 n.1 (2004) ("[A] letter rogatory is the request by a domestic court to a foreign court to take evidence from a certain witness."). The decision to issue such a letter is within the Court's discretion. *B & L Drilling Elecs. v. Totco*, 87 F.R.D. 543, 545 (W.D. Okla. 1978); *In re Urethane Antitrust Litig.*, 267 F.R.D. 361, 364 (D. Kan. 2010); *United States v. Rosen*, 240 F.R.D. 204, 215 (E.D. Va. 2007); *see also* 28 U.S.C. § 1781(b)(2) ("This section does not preclude the transmittal of a letter rogatory or request directly from a tribunal in the United States to the foreign or international tribunal, officer, or agency to whom it is addressed and its return in the same manner."). This Court's issuance of a letter rogatory is the appropriate method of obtaining discovery from Canadian residents. Fed. R. Civ. P. 4(f)(2)(B); Fed. R. Civ. P. 28(b)(1)(B); *see Avago Techs. Gen. IP PTE Ltd. v. Elan Microelectronics Corp.*, No. C04-05385, 2007 WL 1815472, at *1 (N.D. Cal. June 20, 2007) ("[T]he Taiwanese lawyers were residents of a foreign nation that is not a signatory to the Hague Convention. Therefore, the appropriate method for requiring their appearance is the letter rogatory.").

The discovery sought by Microsoft through the attached letter rogatory is both relevant and important to the interests of justice in this case. The proper inquiry for issuance is whether the discovery sought complies with the liberal standard of Federal Rule of Civil Procedure 26. *DBMS Consultants Ltd. v. Computer Assoc. Int'l, Inc.*, 131 F.R.D. 367, 369 (D. Mass. 1990); *Barnes & Noble, Inc. v. LSI Corp.*, No. C 11-02709 EMC LB, 2012 WL 1808849, at *2 (N.D. Cal. May 17, 2012). Both Mr. Ledwell and Mr. O'Donnell were identified by Corel as patent

prosecutors having material information about the asserted patents. [Attach. 1 to Ex. A at 4.] In addition, Corel has refused to refrain from calling them as witnesses at trial. [Attach. 4 to Ex. A at 1.] In addition, some of Corel's patent prosecution counsel located in the United States have indicated that Mr. Ledwell and Mr. O'Donnell had substantive roles in the prosecution of the asserted and related patents. Privilege logs produced by Corel on behalf of third parties also indicate substantial involvement of Mr. Ledwell, Mr. O'Donnell, and their firms with regard to the asserted patents.

As the prosecuting attorneys of the asserted patents and/or related foreign patents, Mr. Ledwell and Mr. O'Donnell are likely to have information regarding the prosecution, conception, reduction to practice, and priority dates of, and prior art to, the asserted patents. Accordingly, they are likely to have information relevant to the parties' claims and defenses. *See, e.g.,* 35 U.S.C. §§ 102 and 103. Microsoft anticipates relying on information obtained from Mr. Ledwell and Mr. O'Donnell to support its non-infringement and invalidity arguments at trial. Additionally, the documents and testimony sought by Microsoft will provide contextual and material information necessary to fully understand the prosecution history of the asserted patents and help the Court make a fair and reasoned claim construction ruling.

Microsoft does not seek information from Mr. Ledwell and Mr. O'Donnell that is duplicative of documents produced by Corel or the prosecuting attorneys in the United States. Rather, Microsoft seeks documents and information that is uniquely in the possession, custody, or control of Mr. Ledwell and Mr. O'Donnell.

Concerns about delay should not prevent the Court from issuing the attached letter rogatory in this matter. Microsoft has diligently sought alternate avenues for obtaining this

discovery, including the preparation of the attached letter rogatory. Any additional delay that might result from consideration of Microsoft's request by a Canadian court will not be unfairly prejudicial to Corel.

CONCLUSION

For the foregoing reasons, Microsoft respectfully requests that the Court approve, date, sign, and seal the proposed letter rogatory accompanying Microsoft's motion. After the Court signs the letter rogatory, Microsoft further requests that the clerk authenticate the Court's signature by affixing the Court's seal thereto, and that the letter rogatory be thereafter returned by the clerk to counsel for Microsoft so that the letter rogatory may be promptly transmitted to the appropriate judicial authority of Canada for execution.

Dated: February 24, 2016

FISH & RICHARDSON P.C.

By: /s/ Bryan K. Basso

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CERTIFICATE OF SERVICE

I hereby certify that on February 24, 2016, I electronically filed the foregoing
DEFENDANT MICROSOFT CORPORATION'S MOTION FOR ISSUANCE OF LETTER
ROGATORY using the CM/ECF system which sent notification of such filing to:

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